

### Remarks

This is in response to the final Office Action mailed on April 2, 2004 and the Advisory Action mailed on June 25, 2004. Claims 10-12, 15-17, and 22-25 are editorially amended to address informalities. None of the amendments to the claims is meant to limit the scope of the claims in any manner. Claims 1-27 remain pending. Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

In the Office Action at paragraphs 5 and 6, the drawings and specification are objected to based on informalities. These informalities have been addressed in the Amendment filed on May 25, 2004. Reconsideration and removal of the objections are respectfully requested.

In the Office Action at paragraph 9, claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodwin et al. (US 6,158,049) in view of Levine, et al. (US 6,349,406) and further in view of Shah et al. (US 6,205,545). This rejection is respectfully traversed, and reconsideration is requested for at least the following reasons.

Claim 1 recites, among other limitations, a performance code marker module for obtaining and storing the run-time internal state data for later retrieval at predefined points corresponding to permanently inserted performance markers.

To establish a *prima facie* case of obviousness, three basic criteria must be met: 1) suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings; 2) a reasonable expectation of success; and 3) the references, when combined must teach or suggest all the claim limitations. See In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143 *et seq.* References that have contrary teachings (i.e., teach away from one another) cannot be combined in an obviousness rejection. MPEP § 2145(X)(D).

It is respectfully suggested for the following reasons that Goodwin and Levine teach away from Shah and therefore cannot be combined in the obviousness rejection.

Goodwin discloses a process that is similar to prior art processes in which code is instrumented to, among other things, allow performance of the code to be measured. See Application, p. 2, 1.3 - p. 3, 1.2. Once performance measurements are taken, the code is "uninstrumented" before final compilation so that the final product does not include the instrumented code.

Specifically, Goodwin discloses instrumenting code to collect profile data. Goodwin col. 6, ll. 30-64. Once the profile data is collected, Goodwin teaches creation of separate uninstrumented "optimized code" as the end product of the process. Goodwin, col. 6, l. 65 - col. 7, l. 39.

Levine similarly distinguishes between instrumented code and uninstrumented code. Specifically, Levine teaches the use of a JAVA interpreter that is itself instrumented such that performance measures may be obtained. Levine, col. 8, ll. 12-17. Levine therefore expressly distinguishes between the instrumented interpreter and the uninstrumented application program.

Shah discloses a debugging tool. It is respectfully suggested that Shah fails to disclose permanently inserted performance markers, as recited by claim 1. However, for the purposes of this response only, it is assumed that Shah does disclose permanently inserted performance markers as stated in the rejection.

Assuming that Shah discloses permanently inserted performance markers, Shah cannot be combined with Goodwin and Levine because both Goodwin and Levine distinguish between instrumented and uninstrumented code and therefore teach away from permanently inserted performance markers. As noted above, Goodwin distinguishes between instrumented code that is profiled and the final optimized code. Levine distinguishes between the uninstrumented application code and the instrumented interpreter. Therefore, Shah, which teaches permanently instrumented code, cannot be combined with Goodwin and Levine, which teach away from such a configuration.

Reconsideration and allowance of claim 1, as well as claims 2-12 that depend therefrom, are respectfully requested for at least these reasons.

Claims 13 and 18 recite permanently inserting one or more code markers into an application program at locations within the application program corresponding to a point at which run-time internal state data is desired. Therefore, claims 13 and 18, as well as claims 14-17 and 19-27 that depend respectively therefrom, should be allowable for at least reasons similar to those provided above with respect to claim 1. Reconsideration and allowance are respectfully requested.

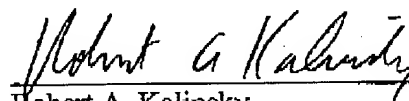
The remarks set forth above provide certain arguments in support of the patentability of the pending claims. There may be other reasons that the pending claims are patentably distinct over the cited references, and the right to raise any such other reasons or arguments in the future is expressly reserved.

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For all of the above reasons, the pending claims are patentable over the prior art of record. Favorable reconsideration in the form of a Notice of Allowance is requested. Please contact the undersigned attorney with any questions regarding this application.

Respectfully submitted,  
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